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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,219	11/28/2000	John McCafferty	13839-00013	7392

7590

08/12/2003

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 08/12/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/726,219

Applicant(s)

MCCAFFERTY ET AL.

Examiner

Padmashri Ponnaluri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-53 is/are pending in the application.
- 4a) Of the above claim(s) 49-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/4/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/971,857.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a continuation of 08/484,893 which is a continuation of 07/971,857 which is a 371 of PCT/GB91/01134.
2. The preliminary amendment A, B filed on 8/23/01, and preliminary amendment C, filed on 11/4/02 have been fully considered and entered into the application.
3. Claims 1-43 have been canceled and new claims 44-53 have been added by the amendment A filed on 8/23/01.
4. Applicant's election without traverse of group I, claims 44-48 and election of 'Fab' as species of binding molecule, in Paper No. 19, filed on 4/17/03 is acknowledged.
5. Claims 49-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 19.
6. Claims 44-48 are currently being examined in this application.
7. NOTE The Petition filed on 5/8/03 has been dismissed.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 44-48 are rejected under 35 U.S.C. 102(a or e) as being anticipated by US Patent 5,427,908 (Dower et al).

The instant claims briefly recite a bacteriophage displaying on its surface a binding molecule selected from group consisting of Fab, single chain Fv antibody and antibody VH domain.

Dower et al teach DNA libraries prepared from cells encoding the protein interest and inserted into or adjacent to a coat protein a bacteriophage vector (i.e., see abstract) (refers to a bacteriophage vector with a fusion coat protein). Dower et al teach in a preferred embodiment ligand peptide is placed in the N-terminus region of the minor coat protein pIII of a bacteriophage (i.e., see column 7). Dower et al teach the desired protein is an immunoglobulin, and a library (refers to the instant claim 48) expressing antibody light chain binding regions combined with antibody heavy chain binding regions (i.e., see column 4 or the claims). The reference clearly anticipates the claimed invention.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 44-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,172,197 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims recite fusion protein with gene III coat protein. The instant claims do not specifically teach the use of gene III coat protein or the fusion protein, however it would be obvious to one skilled in the art at the time the invention was filed the use of gene III coat protein in the fusion protein and displaying the fusion protein on the surface of a bacteriophage.

Claims 44-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 (specifically claim 22) of U.S. Patent No. 5,969,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference claims broadly recite a phage with a fusion protein. However the reference method claims specifically recite the use of the instant claimed vectors.

5. Claims 44-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over pending claims of several copending and co-owned Application Nos. 09/196,522, 09/309639, 09/417478, 09/417479, 09/196586 and 09/706,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because reference (all the different application claims) claims use the instant claimed filamentous phage.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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No claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached from Monday through Friday between 7.30 AM and 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri
Primary Examiner
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pp
August 7, 2003


PADMASHRI PONNALURI
PRIMARY EXAMINER